

tesa 634-WCG
101769-67

REMARKS

Summary of Amendments Made

Claim 1 has been amended to remove some redundant language which appeared to be confusing the issues on Appeal. Claims 15 and 16 are supported in the specification at page 25, line 12.

Claims 1, 2, 4-9 and 13-16 are currently pending. It is believed that no new matter has been added.

35 U.S.C. 103(a) rejections

Claims 1, 2, 4-6, 8, 9, 13 and 14 were rejected as being obvious over Yamamoto et al. (U.S. Patent 6,258,426) in view of Yarusso et al. (U.S. Patent 5,866,249) and claim 7 was rejected as being obvious over Yamamoto et al., Yarusso et al. further in view of Kelch et al. (U.S. Patent 6,127,032).

The applicants' response in their Reply Brief and Appeal Brief are to be considered repeated here. However, the applicants' request reconsideration of these responses in light of how the prior art references were interpreted and for further consideration of the applicants secondary consideration showings.

Note that the claims (even before the above amendments) were directed toward adhesive packaging tapes wherein the pressure-sensitive adhesive composition contained a natural rubber and required the simultaneous presence of at least six separate ingredients, (a)-(f) in claim 1, in discrete amounts. MPEP 2111 states in part that "[d]uring patent examination, the pending claims must be 'given their broadest reasonable interpretation consistent with the specification.' *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)." However, unlike "normal" independent claims which are open to broad interpretation because of the dearth of limitations in the claim, the applicants claim 1 is highly specific with regard to the required ingredients and the amounts therein.

The applicants note that the standard by which claims in a pending application are viewed by the office is not the same standard by which claims of an issued patent are interpreted. "Claims must be read in view of the specification, of which they are a part," *Markman v. Westview Instruments*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995) - "Where the specification makes clear that the invention does not include a particular feature, **the feature is deemed to be outside the reach of the claims of the patent**, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question." While the Examiner is not limited to merely considering the claims of a prior art reference in order to use it to support a *prima facie* case of obviousness, the prior art as a whole must suggest that which is outside the reach of the claims. The applicants hold that there

tesa 634-WCG
101769-57

is no evidence from with Yamamoto or a suggestion from the prior art to substitute critical features with Yamamoto to arrive at a "solventlessly prepared pressure-sensitive adhesive composition" which comprises of a natural rubber, i.e. the adhesives of Yamamoto differ from the applicants' invention in that their invention is directed toward use of acrylates not natural rubbers and use of a solvent in their preparation. That Yamamoto does not encompass the applicants features even if given a generously broad interpretation of their specification is governed by the fact that Yamamoto's crosslinker is used to **decrease** not increase adhesive force after polymerization.

While the above facts alone would subvert a *prima facie* case of obviousness, the applicants also note that given the above differences, the evidence of unexpected results disclosed by the applicants in their comparative examples on pages 34-35 actually offer a closer test against the applicants' claimed invention than against any possible example which can be gleaned from the prior art references cited by the Examiner which is permissible under MPEP 716.02(e) - "Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the Examiner. *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (BPAI 1961)." Office policy is to follow the factors of *Graham v. John Deere* in consideration and determination of obviousness and this includes "Evaluating evidence of secondary considerations." and there is no basis for discounting the evidence proffered by applicants in the specification.

Lastly, with regard to new claims 15 and 16, the teachings of Yamamoto, Yarusso and Kelch in no way suggest a packaging tape with the strength to secure a pallet.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

875 Third Ave., 18th Floor
New York, New York 10022
(212) 808-0700

tesa 634-WCG
101769-87

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Preliminary Amendment (6 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 15 November 2004

By: Agata Gliniska
Agata Gliniska